

REMARKS

The Official Action of July 25, 2001, and the prior art relied upon therein have been carefully reviewed. The claims in the application are now claims 1-9, and these claims define patentable subject matter warranting their allowance. Accordingly, applicants respectfully request favorable reconsideration and allowance.

Acknowledgement by the PTO of the receipt of applicants' papers filed under Section 119 is noted.

New claims 4-9 have been inserted above. These are patentable for the same reasons as claims 1-3, as pointed out below.

Claims 1-3 have been rejected under Section 102 as anticipated by JP '871. This rejection is respectfully traversed.

First, and very importantly, JP '871 absolutely requires zinc (Zn) as an essential component. This is made clear in the claims, in the general description and in the examples of JP '871. Indeed, the smallest quantity of Zn present in any of the examples of JP '871 is 20%, and most of the JP '871 examples contain more than 45% Zn.

On the other hand, Zn as an essential component is excluded from applicants' claims, and is totally excluded

(except possibly as an inevitable impurity) from claim 5 and the claims which depend therefrom.

Another highly significant difference is that the overlay alloy of the present invention must contain an amount of silver (Ag) which is more than 2% up to 10% by weight, and JP '871 contains not a single example which contains an amount of Ag even approaching 2%. As is clearly evident from applicants' disclosure, the presence of more than 2% to 10% Ag insures excellent anti-seizure and fatigue resistance properties for applicants' overlay (see page 3, lines 3-13, as well as Figs. 1 and 2).

On this latter point, the basket or shotgun disclosure of JP '871 cannot be relied upon in a rejection under Section 102. Thus, the law regarding whether or not a generic disclosure anticipates is relatively clear. As a special panel of the Board of Appeals (11-member panel) held in *Ex parte Osmond et al*, 191 USPQ 334, 336 (1973):

It may be true, as urged by the Examiner, that ... the polymers may have molecular weights falling within ranges which overlap that recited in the claims, and that the polymers may be present in concentration ranges which overlap that here claimed. These, however, are isolated disclosures with no teaching that there is any inter-relationship among these features. There is nothing within the patents which would direct a person skilled in the pertinent art to make the selections necessary to formulate a composition having

the specific combination of features here claimed. These patents do not disclose or teach the invention here claimed in such manner as to "give possession of the invention to the person of ordinary skill," cf. *In re Borst* [145 USPQ 554]. In such circumstances, we cannot agree with the examiner that the compositions defined by the claims are "anticipated," within the meaning of 35 U.S.C. 102, by the disclosure of these patents.

Perhaps the seminal case is *In re Petering*, 133 USPQ 275 (1962), which states at page 279:

Even though Appellants' claimed compounds are encompassed by this broad generic disclosure, we do not think this disclosure by itself describes Appellants' invention ... within the meaning of 35 U.S.C. 102(b). [emphasis in original]

Petering went on to state that the references disclosed a smaller preferred class which did act as a description within the meaning of §102(b).

Subsequent to *Petering*, the cases of *In re Ruschig*, 145 USPQ 274 (1965) and *In re Kalm*, 154 USPQ 10 (1967) both held that there was no anticipation in those cases notwithstanding a generic disclosure in the references in question which arguably included or encompassed the subject matter of the claims. The latter case states at page 12:

A rejection under 35 U.S.C. 102(e) for anticipation, such as made by the Patent Office in the present case, necessarily implies that the invention sought to be patented has been "described in a patent granted on an application for patent by another filed in the United States before

the invention thereof by the applicant for patent," and therefore is not "new" - that there are no differences between what is claimed and what is disclosed in the prior art.

As noted above, JP '871 at most discloses a coating alloy optionally containing Ag in a sufficient amount only as part of the generic disclosure, i.e. a so-called "shotgun" or "basket" disclosure, but not in any example. Of the fifteen examples of JP '871, **only one** contained any Ag at all, i.e. the penultimate example, and this example contained only 0.1% Ag.

To paraphrase *Osmond* as quoted above, there is nothing in JP '871 which would direct a person skilled in the present art to make the selections necessary to formulate a composition having the specific combination of features here claimed. JP '871 does not disclose the invention here claimed in such a manner as to give possession of the invention to the person of ordinary skill. In such circumstances, the claimed alloy is not anticipated, within the meaning of 35 U.S.C. 102, by the disclosure of JP '871.

To help facilitate a proper understanding of the present invention in comparison with JP '871, attached are two comparison tables. In the upper table, claims 1-3 of the present invention are compared with claims 1-6 of JP '871. In

the lower table, applicants' examples are compared with the examples of JP '871.

Applicants' arguments above address the Section 102 rejection. No rejection has been imposed under Section 103. However, so that the record will be more complete, applicants respectfully emphasize that the use of the claimed amount of Ag unobviously improves both the anti-seizure and fatigue resistance properties as disclosed at page 3, lines 3-13 and as shown in Figs. 1 and 2 as well as the examples, noting the table at page 6 of applicants' specification.

Applicants respectfully request withdrawal of the rejection.

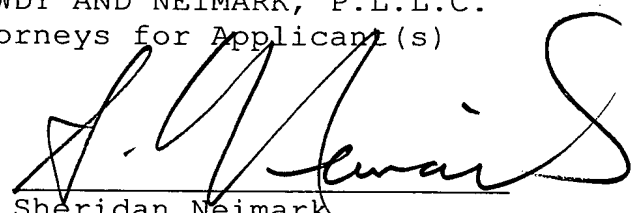
The prior art documents made of record and not relied upon have been noted, along with the implication that such documents are deemed by the PTO to be insufficiently pertinent to warrant their application against any of applicants' claims.

Favorable reconsideration and allowance are
respectfully urged.

Respectfully submitted,

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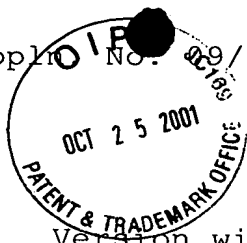
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Version with Markings to Show Changes Made

1. (Amended) A plain bearing comprising a back metal layer, a bearing alloy layer and an overlay which coats said bearing alloy layer,

wherein said overlay is made of a lead-free tin-base alloy which ~~comprises~~ consists essentially of, by weight,

from more than 2% to 10% Ag, and

balance of Sn and inevitable impurities.

2. (Amended) A plain bearing according to claim 1, wherein said lead-free tin-base alloy ~~comprises~~ consists essentially of, by weight, from more than 2.5% to 5% Ag, and balance of Sn and inevitable impurities.

3. (Amended) A plain bearing according to claim 1, wherein said lead-free tin-base alloy ~~further comprises~~ consists essentially of, by weight, from more than 2% to 10% Ag, a total amount of 0.1% to 25% of one or more elements selected from a ~~the~~ group consisting of Cu, Sb, Zn and Ni, and balance of Sn and inevitable impurities.

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COMPARISON BETWEEN THE INVENTION AND JP' 871

OVERLAY OF INVENTION (by wt%)		COATING OF JP' 871 (by wt%)	
Claim 1	2≤Ag<10%, Sn: Bal.	Claim 1	Sn or (Sn and In), Zn: Bal.
Claim 2	2.5≤Ag<5% Sn: Bal.	Claim 2	40≤Sn+In≤70% Zn: Bal.
Claim 3	2≤Ag<10% Total 0.1 to 25% of Cu, Sb, Zn and/or Ni, Sn: Bal.	Claim 3	40≤Sn+In≤70% 20≤Sn≤60% 2≤In≤20% Zn: Bal.
(*Bal. = balance)		Claim 4	Sn or (Sn and In), Sb, Cu, Ag and/or Au, Zn: Bal.
		Claim 5	Sn or (Sn and In), Total 0.05 to 5.0% of Sb, Cu, Ag and/or Au, Zn: Bal.
		Claim 6	Coating = plating film, Sn or (Sn and In), Zn: Bal.

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EMBODIMENTS

No	OVERLAY OF INVENTION (by wt%)						COATING OF JP' 871 (by wt%)						
	Sn	Ag	Zn	In	Cu	Sb	Sn	Ag	Zn	In	Cu	Sb	Au
1	97.2	2.8	0	0	0	0	10	0	80	10	0	0	0
2	96.5	3.5	0	0	0	0	20	0	80	0	0	0	0
3	95.8	4.2	0	0	0	0	20	0	60	20	0	0	0
4	95.0	5.0	0	0	0	0	30	0	49.	20	0	0	.05
5	90.0	10.0	0	0	0	0	30	0	68.	2	0	0	0
6	94.0	5.0	0	0	1.0	0	40	0	45	15	0	0	0
7	94.5	3.5	0	0	0	2.0	40	0	60	0	0	0	0
8							50	0	50	0	0	0	0
9							40	0	47	10	0	3.0	0
10							50	0	39.	10	0.5	0	0
11							60	0	30	10	0	0	0
12							60	0	34.	5	.05	0	0
13							70	0	30	0	0	0	0
14							50	0.1	34.	15	0	0	0
15							80	0	20	0	0	0	0

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